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In re Patent No. 5,271,638  
Issue Date: 31 December, 1993  
Application No. 07/930,997  
Filed: 17 August, 1992  
Attorney Docket No. 9606

SPECIAL PROGRAMS OFFICE  
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ON PETITION

This is a decision on the renewed a petition filed 12 February, 1999 under 37 C.F.R. §1.378(b)<sup>1</sup> to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

The Office regrets the delay in addressing this matter.

The petition is **DISMISSED**.

Your request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.378(e) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.378." Thereafter, no further consideration will be given to a petition under 37 C.F.R. §1.378(b).

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<sup>1</sup> The regulations at 37 C.F.R. §1.378 provide in pertinent part:

(a) The Commissioner may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in the payment of the maintenance fee is shown to the satisfaction of the Commissioner to have been unavoidable (paragraph (b) of this section) or unintentional (paragraph (c) of this section) and if the surcharge required by §1.20(i) is paid as a condition of accepting payment of the maintenance fee. If the Commissioner accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired, but will be subject to the conditions set forth in 35 U.S.C. 41(c)(2).

(b) Any petition to accept an unavoidably delayed payment of a maintenance fee filed under paragraph (a) of this section must include:

- (1) The required maintenance fee set forth in §1.20(e) through (g);
- (2) The surcharge set forth in §1.20(i)(1); and

(3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

(c) Any petition to accept an unintentionally delayed payment of a maintenance fee filed under paragraph (a) of this section must be filed within twenty-four months after the six-month grace period provided in §1.362(e) and must include:

- (1) The required maintenance fee set forth in §1.20(e) through (g);
- (2) The surcharge set forth in §1.20(i)(1); and
- (3) A statement that the delay in payment of the maintenance fee was unintentional. (Emphasis added.)

The patent issued on 21 December, 1993. The grace period for paying the first maintenance fee expired at midnight on 21 December, 1997. The original petition was filed herein on 12 May and dismissed 7 December, 1998.

The Commissioner may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Commissioner to have been unavoidable or unintentional. However, the showing of record at present is inadequate to establish unavoidable or unintentional delay within the meaning of 35 U.S.C. §133 and §41(c)(1), respectively and 37 C.F.R. §1.378(b) and (c), respectively.

It is important to note that Petitioner's filing did not include an adequate showing that the delay in payment of the maintenance fee was unavoidable.

#### STATUTES AND REGULATIONS

Under the applicable provisions of 35 U.S.C. §133 and §41(b) and (c):

- the Commissioner shall charge fees for maintaining in force all patents filed on or after 12 December, 1980, at the 3-year-6-month, 7-year-6-month, and 11-year-6-month intervals; and
- unless payment of the applicable maintenance fee is received in the PTO on or before the date the fee is due or within a grace period of six months thereafter when the grace-period surcharge is paid with maintenance fee, the patent will expire as of the end of the grace period; except that
- the Commissioner may accept the payment of any maintenance fee required by the statute if the payment is made:
  - within 24 months after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unintentional; or
  - at any time after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable.

### Unavoidable Delay

To have the third maintenance fee accepted as unavoidably delayed, Petitioner must:

- make a showing sufficient under 37 C.F.R. §1.378(b) adequate to demonstrate the basis for a claim of unavoidable delay, since reasonable care was taken to ensure that the maintenance fee would be paid timely (details discussed below);
- pay the maintenance fee due (already paid); and
- pay the surcharge after expiration for unavoidable delay.

Petitioner must be aware that, while the surcharge (fee) is smaller for petition alleging unavoidable delay, the "showing" requirement under this portion of the regulation is quite substantial.

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. 133 because 35 U.S.C. 41(c)(1) uses the identical language, *i.e.*, "unavoidable" delay.<sup>2</sup>

In determining if a delay was unavoidable, decisions on reviving abandoned applications have adopted the standard of the reasonably prudent persons acting in their most important business matters.<sup>3</sup> In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."<sup>4</sup>

Finally, a petition to revive an application or patent as unavoidably abandoned or expired cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.<sup>5</sup>

The regulations at 37 C.F.R. §1.378(b)(3) require a showing that:

- the delay was unavoidable since reasonable care was taken to ensure that the

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<sup>2</sup> Ray v. Lehman, 55 F3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)).

<sup>3</sup> Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullah, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

<sup>4</sup> Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

<sup>5</sup> Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

maintenance fee would be paid timely, and

- the showing must enumerate the steps taken to ensure timely payment of the maintenance fee as well as the reasons why payment was not timely made.

This showing should include, but is not limited to, docket records, tickler reports, and file jacket entries for this application, and documents regarding the alleged cause of the delay and copies of any documents referred to in petitioner's statement as to the cause of the unavoidable delay are required.

All the causes which contributed to the failure to timely pay the maintenance fee must be presented and supported with appropriate evidence. It is not sufficient to indicate that Petitioner was unaware or forgot that the maintenance fee was due.

If the cause of the unavoidable delay includes financial hardship, then a complete showing is required of patentee's financial condition--from the earliest that the second maintenance fee could have been paid (21 December, 1996), through the date on which a grantable petition is filed--including all income, expenses, assets, credit, and obligations, which made the delay in payment of the maintenance fee unavoidable. (E.g., Monthly bank statements, annual IRS filings.)

The showing must also enumerate the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. The showing can be verified by using the attached petition form which includes a declaration according to 37 C.F.R. §1.68. Statements from all persons who contributed to the delay are also required. Further, petitioner should identify the party(ies) responsible for making the payment. (See: NOTE, below.)

If the Petitioner is unable to show that the delay was unavoidable, alternatively and as previously noted, the Petitioner may make a showing that the delay was unintentional under 37 C.F.R. §1.378(c). (See Fn. 1, and discussion below.)

#### Unintentional Delay

While the burden is less onerous to show unintentional delay under the provisions of 37 C.F.R. §1.378(c), the application of that portion of the regulation is limited to those cases in which the 24-month time limitation is satisfied. In the instant case that requirement could be met on the date of filing of the original petition herein. Moreover, while the surcharge (fee) is substantially larger, there is no "showing" requirement and Petitioner need only state that the delay was unintentional.

To have the third maintenance fee accepted as unintentionally delayed, Petitioner must:

- submit a petition under 37 C.F.R. §1.378(c)--forms available at the Office website, [www.uspto.gov](http://www.uspto.gov) (see Printable Forms);
- pay the maintenance fee due (already submitted); and
- pay the surcharge after expiration for unintentional delay.

Petitioner may also find a current fee schedule at [www.uspto.gov](http://www.uspto.gov)

Further correspondence with respect to this matter should be addressed as follows:

By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23  
2201 South Clark Place  
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to Petitions Attorney John J. Gillon, Jr., at (703) 305-9199.

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